Remarks

Claims 1, 2, 4-6, and 8-22 are pending. All claims are rejected 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,797,898 to Santini Jr. et al. (hereinafter "Santini"). The rejection is respectfully traversed.

Examination of this Application Fails to Comply with 37 C.F.R. § 1.104 and M.P.E.P § 707.07.

Applicant's submit that examination of the instant application has failed to comply with applicable rules and procedures prescribed for the examination of patent applications. The Office has issued two non-final office actions, evidencing improper piecemeal examination and providing absolutely no explanation for the current prior art rejection, as detailed below.

37 C.F.R. § 1.104(a)(2) states that

> On taking up an application for examination …, the examiner shall make a … **thorough investigation of the available prior art** relating to the subject matter of the claimed invention. The **examination shall be complete** with respect both to compliance of the application … with the applicable statutes and rules and to the patentability of the invention as claimed….

37 C.F.R. § 1.104(c)(2) states that

> In rejecting claims for want of novelty…, **the examiner must cite the best references at his or her command**. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. **The pertinence of each reference, if not apparent, must be clearly explained** and each rejected claim specified.

M.P.E.P. § 707.07(g) states that

> Piecemeal examination should be avoided as much as possible. The examiner ordinary should reject each claim **on all valid grounds available**...

The cited reference, Santini, was at the examiner's command *before* the first office action mailed June 8, 2007, since it was cited by Applicants in an Information Disclosure Statement mailed July 1, 2004. Yet, the examiner failed to apply this, or any prior art, reference in the *first* office action, as should have been done under 37 C.F.R. § 1.104(a) and (c) if the Examiner had made a thorough investigation of the available prior art, done a complete examination, and believed that a prior art rejection was warranted and Santini to be the best reference.[1]

That error now is compounded by that fact that the *second* office action, mailed December 13, 2007, is devoid of any reason or explanation for the rejection over Santini. The examiner has failed to comply with the mandate under 37 C.F.R. § 1.104(c)(2) that the pertinence of each reference be clearly explained, where, as here, it is not apparent.

Nevertheless, Applicant's will explain why the latest rejection is improper and must be withdrawn.

Applicants' Claims Are Novel and Non-obvious Over Santini.

The methods of applicants' claims 1 and 6 require, in pertinent part, **heating** one of the reservoir caps of the implantable device in an amount effective to cause the reservoir cap to

[1] Santini could not have *become* the best reference by virtue of Applicant's response to the first office action, because the narrowing amendments which accompanied Applicant's response to the first office action undoubtedly were not made in response to the obviousness-type double patenting rejection set forth in the first office action, since Applicants filed a terminal disclaimer to obviate that rejection.

rupture, in order to open the reservoir. In contrast, Santini discloses an *electrochemical* mechanism for disintegrating a reservoir cap. The electrochemical mechanism is entirely different; it does not rely on heating. Rather, in the electrochemical mechanism, the reservoir cap functions as an anode and a physically separate cathode is provided nearby, such that when the device is placed into a conductive fluid and an electrochemical cell is created with the cathode, anode, and conductive fluid, then the reservoir cap will oxidize (Col. 5, Ln. 64 to Col. 6, Ln. 14) The oxidized metal is soluble and dissolves into the conductive fluid, thereby opening the reservoir. This mechanism does not involve heating the reservoir cap. Therefore, the mechanism of corrosion and dissolution taught in Santini is clearly is neither identical to nor suggestive of Applicant's claimed method of rupturing a reservoir cap by the generation of an effective amount of heat.

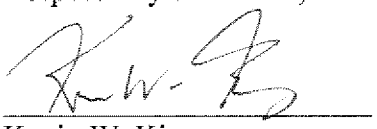
In addition, Santini does not anticipate or render obvious claim 8 or claim 16 because nothing in Santini discloses or suggests that reservoir cap can be heated to cause it to rupture by thermal expansion or by a phase change that including melting of the reservoir cap.

Furthermore, Santini does not anticipate or render obvious claims 21-22 because nothing in Santini discloses or suggests including a thin film resistor as part of the device or heating the reservoir cap by using a thin film resistor.

In sum, Santini does not teach the steps or device structure for Applicant's presently claimed method for controlled reservoir opening.

Prompt allowance of claims 1, 2, 4-6, and 8-22 is therefore respectfully requested. In order to avoid further and unnecessary delay, the undersigned respectfully invites the Examiner to contact him by telephone (404.853.8068) if any issues can be resolved by conference or examiner's amendment to facilitate allowance of applicants' claims.

Respectfully submitted,



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